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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,005	04/21/2004	Myron L. Munn		5504
31083	7590	03/20/2008	EXAMINER	
THOMTE LAW OFFICE, L.L.C. 2120 S. 72ND STREET, SUITE 1111 OMAHA, NE 68124				KURTZ, BENJAMIN M
ART UNIT		PAPER NUMBER		
1797				
MAIL DATE		DELIVERY MODE		
03/20/2008		PAPER		

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MYRON L. MUNN

Appeal 2008-0734
Application 10/829,005
Technology Center 1700

Decided: March 20, 2008

Before CHUNG K. PAK, CHARLES F. WARREN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

WARREN, *Administrative Patent Judge*.

DECISION ON APPEAL

Applicant appeals to the Board from the decision of the Primary Examiner finally rejecting claims 4 and 6 through 8 in the Office Action mailed January 18, 2007, which claims were subsequently amended in the Amendment filed February 12, 2007 entered in the Advisory Action mailed March 9, 2007. 35 U.S.C. §§ 6 and 134(a) (2002); 37 C.F.R. § 41.31(a) (2006).

We affirm the decision of the Primary Examiner.

Claim 4 illustrates Appellant's invention of an oil filter adapter, and is representative of the claims on appeal:

4. An oil filter adapter for attachment to the externally threaded filtered oil tube extending outwardly from an oil filter receptacle of an automotive engine which normally threadably receives the internally threaded filtered oil outlet at one end of a standard oil filter canister with the one end thereof having a canister O-ring or gasket provided thereon, the adapter enabling a replacement oil filter canister to be substituted for the standard oil filter canister with one end of the replacement oil filter canister having a canister O-ring or gasket provided thereon outwardly of an internally threaded filtered oil outlet, the standard and replacement oil filter canisters having substantially the same diameter with the replacement oil filter canister having a greater length than the standard oil filter canister to provide a greater filter capacity thereof, the replacement canister O-ring or gasket having a greater diameter than the standard canister O-ring or gasket, the oil filter adapter comprising:

a disc-shaped adapter member having an engine side and a filter side; said engine side of said disc-shaped adapter member having an annular O-ring or gasket groove formed therein; an O-ring or gasket positioned in said O-ring or gasket groove of said disc-shaped adapter member which is adapted to sealably engage the oil filter receptacle; said O-ring or gasket positioned in said O-ring or gasket groove of said disc-shaped adapter member having the same diameter as said standard canister O-ring or gasket; said disc-shaped adapter member having an internally threaded central opening formed therein which extends inwardly from said engine side thereof which is adapted to threadably receive the externally threaded filtered oil tube of the oil filter receptacle; said disc-shaped adapter member having an externally threaded, hollow nipple extending from its said filter side at the center thereof which is in communication with the interior of said internally threaded central opening in said disc-shaped adapter member;

the threads of said hollow nipple matching the threads of the oil outlet of the replacement oil filter canister;

said disc-shaped adapter member having a plurality of spaced-apart unfiltered oil passageways formed therein which extend therethrough from said engine side to said filter side thereof outwardly of said central opening of said disc-shaped adapter member;

said filter side of said disc-shaped adapter member having an annular seat formed thereon which is positioned outwardly of said hollow nipple and said unfiltered oil passageway thereof;

the internally threaded filtered oil outlet of the replacement oil filter canister selectively threadably receiving said externally threaded hollow nipple whereby the canister O-ring or gasket of the replacement oil filter canister may be drawn into sealing engagement with said annular seat on said filter side of said disc-shaped adapter member.

The Examiner relies upon the evidence in this reference (Ans. 3):

Sparling 5,766,451 Jun. 16, 1998

Appellant requests review of the following grounds of rejection advanced on appeal (App. Br. 4-7):

claims 4 and 7 under 35 U.S.C. § 102(b) as anticipated by Sparling (Ans. 3);

claim 6 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as being obvious over Sparling (Ans. 4); and

claim 8 under 35 U.S.C. § 103(a) as being obvious over Sparling (Ans. 5).

Appellant separately argues the claims in the first ground of rejection. App. Br. 7-8. Thus, we decide this appeal based on claims 4 and 6 through 8. 37 C.F.R. § 41.37(c)(1)(vii) (2006).

The basic issues in this appeal are whether the Examiner has carried the burden of establishing a prima facie case in each of the grounds of rejection advanced on appeal.

The principal issue involves the interpretation of the preamble of claim 1. The plain language of claim 4 as a whole specifies an oil filter

adapter comprising at least the parts specified in the clauses in the body of the claim. The preamble consists of two parts. We determine the first part, “for attachment” to “an oil filter receptacle of an automotive engine,” must be given weight to the extent of requiring that the adapter fit at least the oil filter receptacle of an automotive engine, but without limitation on the receptacle or the engine.

We determine that in the second part, “the adapter enabling a replacement oil filter canister to be substituted for the standard oil filter canister,” the two canisters have “substantially the same diameter” to any extent and the “replacement canister” has a greater length in order “to provide a greater filter capacity” to any extent, and the diameter of the O-ring or gasket of the “replacement canister” is greater to any extent, however small, than that of the “standard canister.” In light of the disclosure in the Specification, we determine the “standard canister” is the filter recommended for an automotive engine by the manufacturer and a “replacement filter” is any other filter which one may desire for service on that engine. Indeed, we find no definition for the term “replacement filter” in the Specification. Spec., e.g., 1-2. *See, e.g., In re Am. Acad. of Sci. Tech. Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004), and cases cited therein.

Upon considering the second part of the preamble in view of the record as a whole taken in light of Appellants’ arguments (App. Br. 7; Reply Br. 1-2), we agree with the Examiner (Ans. 6) that this language constitutes a statement of intended use as there is no correlation between the canister diameter, canister length, and diameter of a canister O-ring or gasket of a “standard canister” and any desired “replacement canister,” and a structural limitation of any component of the oil filter adapter as specified in the rest of

claim 4. *See, e.g., Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305 (Fed. Cir. 1999);¹ *Corning Glass Works v. Sumitomo Elect. U.S.A., Inc.*, 868 F.2d 1251, 1257 (Fed. Cir. 1989); *In re Stencel*, 828 F.2d 751, 754-55 (Fed. Cir. 1987), and cases cited therein (“Whether a [statement] . . . of intended purpose constitutes a limitation to the claims is, as has long been established, a matter to be determined on the facts of each case in view of the claimed invention as a whole.”).

We find Sparling would have disclosed to one of ordinary skill in this art an oil filter adapter which, as described and illustrated in this reference, corresponds, as a matter of fact, with the claimed structural elements of the oil filter adapter specified in claim 4 in the manner pointed out by the Examiner. Ans. 3-4; *see* Sparling, e.g., col. 3, l. 66 to col. 5, l. 5, col. 6, l. 44 to col. 8, l. 57, and Figs. 1, 2, and 4. Sparling’s adapter is threaded for any “attachment conventionally used in automotive engines” and for “attachment of any conventional industry standard spin on oil filter.” Sparling col. 4, ll. 14-24 and col. 5, ll. 1-5; *see also* col. 6, ll. 58-61, col. 7, ll. 53-57, and Fig. 1. Sparling discloses the adapter “could also be

¹ If the claim preamble, when read in the context of the entire claim, recites limitations of the claim, or, if the claim preamble is ‘necessary to give life, meaning, and vitality’ to the claim, then the claim preamble should be construed as if in the balance of the claim If, however, the body of the claim fully and intrinsically sets forth the complete invention, including all of its limitations, and the preamble offers no distinct definition of any of the claimed invention’s limitations, but rather merely states, for example, the purpose or intended use of the invention, then the preamble is of no significance to claim construction because it cannot be said to constitute or explain a claim limitation.

Pitney Bowes, 182 F.3d at 1305.

configured to fit any filter by changing the filter end 40 to a configuration to match the desired filter.” Sparling col. 7, ll. 57-59, and Fig. 1.

Appellant acknowledges in the Specification that a Ford F-350 truck has a metric externally threaded oil filter attachment nipple and commercially available filters can have English system internal mounting threads. Spec 1:17-2:3 and 6:2-3.

We are not persuaded by Appellant’s contentions (App. Br. 7) that the Examiner’s finding of anticipation of claim 4 under § 102(b) over Sparling is in error because of the second part of the preamble of this claim in view of our interpretation thereof and the term “a replacement canister” above. As we determined above, the difference in O-ring or gasket diameter between a “standard” canister and any desired “replacement” canisters can be very small, and Appellant does not argue that the ninth clause of claim 4, defining annular seat element 46, thus has a specific size limitation when no such limitation is stated therein. *See* App. Br. 7. Such limitation is not disclosed in the Specification. *See* Spec. 7:4-6 and Fig. 3. Indeed, one skilled in this art armed with the knowledge in this art would have, as a matter of fact, found in Sparling the description of an oil filter adapter which can have a filter end configuration 40 that would accommodate the O-ring or gasket diameter of any desired “replacement” canister, thus placing this person in possession of the claimed oil filter adapter encompassed by claim 4. *See, e.g., In re Graves*, 69 F.3d 1147, 1152 (Fed. Cir. 1995), and cases cited therein (“[A] skilled artisan could take [the reference’s] teachings in combination with his own knowledge and be in possession of the [claimed system] device.”); *see also, e.g., In re Preda*, 401 F.2d 825, 826 (CCPA 1968) (“[I]n considering the disclosure of a reference, it is proper to take

into account not only specific teachings of the reference but also the inferences which one skilled in the art would reasonably be expected to draw therefrom.” (citation omitted)).

Dependent claim 7 modifies claim 4 by specifying, in pertinent part, “annular seat on said filter side . . . has a width sufficiently large enough to enable replacement oil filter canister O-rings or gaskets of various diameters to be placed into sealing engagement.” We are of the opinion that unspecified “various diameters” of O-rings or gaskets of unspecified “replacement” canisters include very small differences in diameter which provide little additional size limitation on annular seat 46 than does the second part of the preamble of claim 4 with respect to the annular seat limitation in that claim. Thus, we are not convinced by Appellant’s contentions that this claim patentably distinguishes over Sparling for the same reasons we set forth with respect to claim 4 above.

Accordingly, the Examiner has established that, *prima facie*, as a matter of fact, Sparling describes to and places in possession of one skilled in the art of oil lubricating systems familiar with the attachment of oil filter canisters on automotive engines, each and every element of the claimed oil filter adapter encompassed by claims 4 and 7, arranged as required therein. *See, e.g., In re Schreiber*, 128 F.3d 1473, 1477 (Fed. Cir. 1997), and cases cited therein (“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently.”). Therefore, we affirm this ground of rejection.

Turning now to the separate grounds of rejection of dependent claim 6 under §§ 102(b) and 103(a),² this claim modifies claim 4 by specifying the adapter is internally threaded with “SAE” threads and the hollow nipple thereof is externally threaded with “metric” threads. The “SAE” threads are unspecified and indeed, undisclosed in the Specification.³ Thus, we are of the view that “SAE” threads include any conventional threading, metric or English system, on the oil filter attachment nipple of any automotive engine. The external metric threads on the hollow nipple would receive the internal mounting metric threads of filters.

We find convincing evidence supporting the Examiner’s position with respect to each ground of rejection (Ans. 4) in Sparling’s description of appropriate threading to attach the adapter to the desired engine and to the desired filter canister. Indeed, Appellant acknowledges that a truck engine is known which requires metric threaded filters. Thus, one skilled in this art armed with the knowledge in this art would have, as a matter of fact, found in Sparling the description of an oil filter adapter which can have metric threads as claimed, thus placing this person in possession of the claimed oil filter adapter encompassed by claim 6 within the meaning of § 102(b). *See, e.g., Graves*, 69 F.3d at 1152, and cases cited therein; *see also, e.g., Preda*, 401 F.2d at 826. Furthermore, in view of the conventionality of the threading of Sparling’s oil filter adapter, one of ordinary skill in this art would have been led by Sparling to design and implement with predictable

² A rejection of a claim under § 102(b) and alternatively under § 103(a), constitutes a separate ground of rejection under each statutory provision. *See, e.g., In re Spada*, 911 F.2d 705, 707 n.3 (Fed. Cir. 1990).

³ The term “SAE” is not used in the Specification and it appears to be the acronym for the Society of Automotive Engineers.

success an adapter based on the threading necessary to combine an automotive engine with a desired oil filter canister, thus arriving at a claimed oil filter adapter encompassed by claim 6 within the meaning of § 103(a). *See KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727, 1740 (2007).

We are not convinced that Appellant has sufficiently rebutted the *prima facie* case with respect to either ground of rejection of claim 6 as we interpreted this claim above. Indeed, Appellant has not established that the capability to use a “larger capacity replacement oil filter canister” in place of the “standard” canister for an automotive engine patentably distinguishes the claimed oil filter adapter encompassed by claim 6 over Sparling with respect to either ground of rejection.

Accordingly, the Examiner has established that, *prima facie*, as a matter of fact, Sparling describes to and places in possession of one skilled in this art, each and every element of the claimed oil filter adapter encompassed by claim 6, arranged as required therein under § 102(b), *see, e.g., Schreiber*, 128 F.3d at 1477, and cases cited therein; and that the claimed adapter encompassed by claim 6 would have been *prima facie* obvious to one of ordinary skill in this art over Sparling under § 103(a). *See KSR*, 127 S. Ct. at 1740. Therefore, we affirm these grounds of rejection.

The plain language of dependent claim 8 modifies the oil filter adapter of claim 4 by specifying that the adapter must be “of one piece construction.” Sparling would have disclosed the exploded view of an adapter in Fig. 1 as well as a cutaway view of the assembled adapter in Fig. 3. We determine that one of ordinary skill in this art would have been led by Sparling’s illustrations to design and implement with predictable success a one piece adapter which can receive gasket 36 and seal 16 (Starling, *e.g.*,

col. 7, ll. 39-43, col. 8, ll. 32-47, and Figs. 1 and 3), thus arriving at a claimed oil filter adapter encompassed by claim 6 within the meaning of § 103(a). *See KSR*, 127 S. Ct. at 1740. Appellant's contentions based on the one piece construction of the claimed oil filter adapter do not address whether one of ordinary skill in the art would have been led to a one piece oil filter adapter by the teachings of Sparling.

Accordingly, the Examiner has established that, *prima facie*, the claimed adapter encompassed by claim 8 would have been *prima facie* obvious to one of ordinary skill in this art over Sparling under § 103(a). Therefore, we affirm this ground of rejection

The Primary Examiner's decision is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

AFFIRMED

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